

### REMARKS

Reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

### Status of the Claims

Claims 1-5, 7-12, 15 and 16 are pending. Claims 1, 8, and 16 have been amended. No new matter has been added. Claims 6, 13 and 14 have been cancelled without prejudice or disclaimer of the subject matter recited therein.

Claim 1 has been amended to recite all the elements of cancelled dependent claim 6.

Claim 8 has been amended to recite all the elements of cancelled dependent claims 13 and 14.

Claim 16 has been amended to recite all the elements of cancelled claim 6.

### **Rejection Under 35 U.S.C. § 103**

Claims 1-4, 6-11 and 13-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,425,081 to Iwamura (“Iwamura”) in view of U.S. Patent Application Publication No. 2001/0037313 to Lofgren et al. (“Lofgren”). Claims 6, 13 and 14 have been cancelled, thus rendering the rejection moot with respect to claims 6, 13 and 14.

The Examiner contends that Iwamura discloses most of the features of claim 1. However, the Examiner acknowledges that Iwamura does not disclose “extracting the digital watermark and comparing it against the digital watermark stored in the database.” The Examiner contends that Lofgren discloses “[t]he watermark reader reads a watermark and computes a hash of a captured image and passes the hash to the central site for comparison with the database of image hashes.” (Detailed Action, page 3, item 6.) The Examiner states that it would have been

obvious to a person of ordinary skill in the art to combine Iwamura and Lofgren to achieve the invention of claim 1.

Amended claim 1 recites “a unit operable to update said digital watermark information stored in said database and said digital watermark information embedded in said authentic image in said personal certificate each time said watermark information inquiring unit judges said digital watermark information to be justifiable.” Amended independent claim 8 similarly recites “said digital watermark information stored in said database and embedded in said authentic image of said personal certificate is updated according to predetermining timing, wherein said predetermined timing includes each time said system correctly justifies an authentic image.” Applicant respectfully submits that the combination of Iwamura and Lofgren neither discloses nor suggests updating the stored and the embedded digital watermark either each time the digital watermark information is judged to be justifiable or at a predetermined time. Therefore, Iwamura and Lofgren neither disclose nor suggest, singly or in combination, the invention of claims 1 and 8. Thus, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness over claims 1 and 8.

Claims 2-4 depend from claim 1. Claims 7-11 depend from claim 8. Claims 2-4 and 7-11 recite their own features in addition to the features of their respective base claim. Claims 2-4 and 7-11 are patentable over Iwamura and Lofgren for at least the same reasons discussed above with respect to claims 1 and 8. Therefore, Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness over claims 2-4 and 7-11.

Reconsideration and withdrawal of the rejection is requested.

Claims 5 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwamura and Lofgren in view of U.S. Patent No. 6,778,678 to Podilchuk et al. ("Podilchuk").

The Examiner acknowledges that the combination of Iwamura and Lofgren does not disclose, or suggest, "having the element of the digital watermark randomly generated." However, the Examiner cites Podilchuk as disclosing this feature. The Examiner states that it would have been obvious to a person of ordinary skill in the art to combine Iwamura, Nakano and Podilchuk to achieve the invention of claims 5 and 12.

Claim 5 depends from claim 1, and recites the features of claim 1 as if set forth in their entirety therein. Claim 12 depends from claim 8, and recites the features of claim 8 as if set forth in their entirety therein. Applicants submit that Podilchuk neither discloses nor suggests those features of claims 5 and 12 missing from the combination of Iwamura and Lofgren, as demonstrated above for claims 1 and 8. Therefore Iwamura, Lofgren and Podilchuk neither disclose nor suggest, singly or in combination, the invention of claims 5 and 12. Thus, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness over claims 5 and 12. Reconsideration and withdrawal of the rejection is requested.

### **Rejection Under 35 U.S.C. § 102**

Claim 16 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Iwamura.

Amended claim 16 recites "said digital watermark information stored in said database and said digital watermark information embedded in said authentic image in said personal certificate each time said digital watermark information in said authentic image in said personal certificate is judged to be justifiable." Applicant respectfully submits that Iwamura does not disclose nor suggest the recited timing of updating the digital watermark stored in the

database and the digital watermark embedded in the authentic image in the personal certificate each time the digital watermark information is judged to be justifiable. Therefore, Iwamura does not disclose each and every element of claim 16. Thus, Iwamura does not anticipate claim 16. Reconsideration and withdrawal of the rejection is requested.

## CONCLUSION

Each and every point raised in the Office Action dated July 27, 2005 has been addressed on the basis of the above amendments and remarks. In view of the foregoing it is believed that claims 1-5, 7-11 and 15-16 are in condition for allowance and it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining which the Examiner believes could be resolved through a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

Respectfully submitted,

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